

DOCKET NO: 231191US26

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ALINE ABERGEL : EXAMINER: WEEKS, GLORIA R
SERIAL NO: 10/698,415 :
FILED: NOVEMBER 3, 2003 : GROUP ART UNIT: 3721
FOR: PACKAGING A PRODUCT AND :
PACKAGING METHOD

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply to the Examiner's Answer dated July 27, 2007.

I. STATUS OF THE CLAIMS

Claims 1-16, 18, and 25-33 are pending. Claims 17 and 19-24 are canceled and Claims 25-28 were withdrawn from consideration. Claims 1-16, 18, and 29-33 stand rejected, and Claims 1-16, 18, and 29-33 are herein appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-3, 8, 9 and 13-15 are unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Publication No. 2004/0003825 to Kelly (hereinafter "Kelly") in view of U.S. Patent No. 4,491,389 to Coburn, Jr. (hereinafter "Coburn") and U.S. Patent No. 6,412,640 to Destanque et al (hereinafter "Destanque"). Claims 2, 3, 8, 9 and 13-15 all depend from independent Claim 1.

Whether Claim 10 is unpatentable under 35 U.S.C. § 103(a) as obvious over Kelly in view of Coburn and Destanque and further in view of WO 97/15910 to Guiard (hereinafter "Guiard"), U.S. Patent No. 7,025,220 to Verespej et al. (hereinafter "Verespej") and U.S. Patent No. 4,469,226 to Matney (hereinafter "Matney"). Claim 10 depends from independent Claim 1.

Whether Claims 11 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kelly in view of Coburn and Destanque and further in view of U.S. Patent No. 4,890,872 to Parrotta et al. (hereinafter "Parrotta"). Claims 11 and 12 both depend from independent Claim 1.

Whether Claims 7, 16, 18 and 33 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kelly in view of Guiard and Parrotta. Claims 7, 18, and 33 all depend from independent Claim 16.

Whether Claims 4-6 and 29 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kelly in view of Guiard and Parrotta and further in view of Coburn. Claims 4-6 and 29 all depend from independent Claim 16.

Whether Claims 30-32 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kelly in view of Guiard, Parrotta and Coburn and further in view of Verespej and Matney. Claims 30-32 all depend from independent Claim 16.

III. ARGUMENT

The Examiner's Answer clarifies certain aspects of the final rejections. Nevertheless, Appellant still believes that the final rejections are improper for the reasons provided in the Appeal Brief, and for the following additional reasons, which address points raised in the Examiner's Answer.

A. The Examiner's Answer fails to properly identify and make of record the evidence relied upon in rejecting the pending claims.

The Examiner's Answer appears to rely upon an unidentified edition of the *American Heritage Dictionary* in interpreting the language recited in the claims. In particular, the Examiner's Answer cites, for the first time during the pendency of this application, the *American Heritage Dictionary* in support of its interpretation of the meaning of the claim terms "sticker" and "adjacent to."¹

To the best of Appellant's knowledge, the *American Heritage Dictionary* was not previously cited by the PTO, and has never been made of record in this application. The Examiner's Answer fails identify the publication date or edition of the *American Heritage Dictionary* that is relied upon to interpret the claim terms, and the *American Heritage Dictionary* is not listed in the section of the Examiner's Answer titled "Evidence Relied Upon."² Thus, the *American Heritage Dictionary* has not been properly made of record in this case.

While the inclusion of the noted definitions in the Examiner's Answer may provide a more complete impression of how the PTO is interpreting the terms "sticker" and "adjacent to", it is submitted that the definitions presented in the Examiner's Answer can not be relied upon as evidence of what a person of ordinary skill in the art at the time of the invention would understand a "sticker" or "adjacent to" to mean in the absence of the underlying

¹ See the Examiner's Answer at page 10 and page 12.

² See the Examiner's Answer at pages 8-9.

reference being properly made of record. Accordingly, for the purposes of this Reply Brief, Appellant will treat the above noted definitions of "sticker" and "adjacent" as being the Examiner's own interpretation in isolation, without the evidentiary support of any verifiable reference.

B. There is no apparent reason to replace the hinge 24 of Kelly with the cushion mirror 12 of Coburn.

The Examiner's Answer asserts that "Examiner finds that it would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the cosmetic case of Kelly to provide a mirror sticker, since Coburn, Jr. has taught stickers to be an inexpensive means of providing reflective surfaces, to an inner surface of the lid of the cosmetic case, as well as to the outer surface of the lid and support, as suggested by Destanque et al. As the outermost surfaces of the cosmetic case of Kelly is in the form of a single sticker that articulates the lid to the support, the modified dual mirrored surface cosmetic case of Kelly would disclose the cosmetic case of Appellant's invention as claimed."³

Thus, the Examiners Answer characterizes the cited references as follows:

- (1) Coburn suggests a mirror in the form of a sticker;
- (2) Kelly suggests "a single sticker that articulates the lid to the support";

The Examiner's Answer bases these assertions on a sticker being defined as "[o]ne that sticks, as a gummed or adhesive label or patch."⁴ As discussed above, this definition is completely unsupported. Moreover, the Examiner's Answer extrapolates this unsupported definition to mean that *anything* with an adhesive is a sticker. A ceramic tile that is adhered to a floor or a rubber sole that is adhered to a leather upper of a shoe are both examples of "one that sticks," but these items could hardly reasonably be considered to be a "sticker."

³ See the Examiner's Answer at page 11, line 15 to page 12, line 2.

⁴ See the Examiner's Answer at 10, FN 1.

Moreover, it would be highly dubious to suggest that simply because these items include an adhesive that they would be an obvious replacement for the hinge 24 described in Kelly. Similarly, other than through piecemeal hindsight reconstruction based on Appellant's own disclosure, there is no apparent reason to *deconstruct* the mirror 12 of Coburn, which is described as including *a plastic layer* 14, as well as a closed cell polyether foam 26, polyester 28, and a metallized surface 30,⁵ in order to arrive at the subject matter recited in the claims of the present invention.

Nevertheless, assuming *arguendo* that the hinge 24 described in Kelly can be interpreted as a "sticker", and that the mirror 12 described in Coburn can also be defined a "sticker", it does not necessarily follow that there is an apparent reason to combine these elements in the fashion recited in Claim 1. Figure 1 of Kelly and Figure 1 of Coburn are reproduced below. As can be seen in Figure 1 of Kelly, a mirror 22 is secured to a lid 16 of a cosmetics case. Figure 1 of Coburn illustrates a compact 10 that "includes a top 14 provided with a support surface 15 for supporting the mirror 12."⁶ Thus both Kelly and Coburn describe cases that include a mirror on *the same single surface*: the interior of a lid.

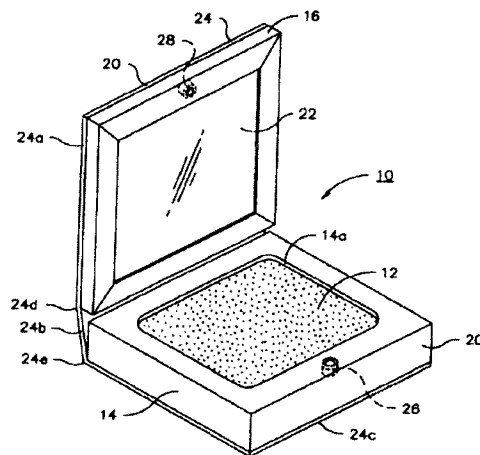


Fig. 1

Figure 1 of Kelly

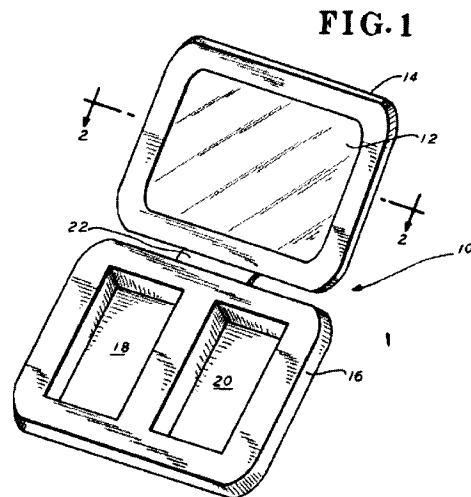


Figure 1 of Coburn

⁵ See Coburn, at column 2, lines 57-64.

⁶ See Coburn at col. 2, lines 36-38.

By contrast, Claim 1 recites a support and a lid that are articulated to each other by an arrangement including a sticker forming a mirror adhesively bonded onto (1) a face of the lid and onto (2) one of the faces of the support. The Examiner's Answer acknowledges that Claim 1 requires that a single mirror be bonded to more than just the lid, stating that "[t]he cosmetic case of Kelly further discloses a mirror, however, the mirror is adhesively bonded only to the lid of the cosmetic case, rather than both the lid and support as claimed in Appellant's invention."⁷ Nevertheless, the Examiner's Answer asserts that it would be obvious "to further modify the cosmetic case of Kelly to provide a mirror sticker, since Coburn, Jr. has taught stickers to be an inexpensive means of providing reflective surfaces, to an inner surface of the lid of the cosmetic case, as well as to the outer surface of the lid and support, as suggested by Destanque et al."⁸ Appellant respectfully disagrees.

Destanque does not disclose or suggest a mirror adhesively bonded onto (1) a face of the lid and onto (2) one of the faces of the support. Instead, Destanque describes that *the internal face of lids 10a and 10b* of a case 2 may include mirrors 38a and 38b, as shown in Figure 1 of Destanque, and that "[i]n addition (or as an alternative), *another mirror* may be provided on the attached double bottom 6c (FIG. 4)."⁹ Thus, Destanque describes multiple, separate mirrors that are each individually placed on either a lid of a case, as described in Kelly and Coburn, and/or a bottom of a case.

In order to make the giant leap from three references that describe single mirrors on single faces to a mirror adhesively bonded onto (1) a face of the lid and onto (2) one of the faces of the support, the Examiner's Answer appears to rely on its own broad interpretation of the term "sticker" while disregarding the teachings of the cited references as a whole.

However, as stated in *Panduit Corporation v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1093, 227 USPQ 337, 344 (Fed. Cir. 1985) "[t]he well established rule of law is that each

⁷ See the Examiner's Answer at page 10, lines 17-19.

⁸ See the Examiner's Answer at page 10, lines 16-19.

⁹ See Destanque, at col. 4, lines 55-64, emphasis added.

prior art reference must be evaluated as an entirety, and that all of the prior art must be evaluated as a whole.” See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *In re Kuderna*, 426 F.2d 385, 390, 165 USPQ 575, 578-79 (CCPA 1970). Furthermore, “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

In this case, the Examiner's Answer selectively focuses, to the exclusion of the other parts necessary to the full appreciation of what these references fairly suggest to one skilled in the art, on how the hinge 24 of Kelly and the mirror 12 of Coburn are each attached to their respective cases (adhesively) in order to characterize them both as “stickers”.

Specifically, Coburn is directed reducing distortion problems in conventional mirrors. Coburn asserts that this objective is met by a mirror “which includes a cushion intermediate the mirror's reflecting surface and the mirror's support surface which cushion absorbs any surface irregularity in the support surface and causes the support surface to present a *substantially flat support surface* to the reflecting surface whereby any distorting effect of the surface irregularity on images produced by the reflecting surface is substantially eliminated.”¹⁰ Thus, rather than suggesting to replace a hinge, a dynamic structure, with a mirror, Coburn describes the opposite: presenting a substantially flat, static, cushion support surface to remove distortion from a mirror.

Moreover, when presented with the description of *separate mirrors* on separate faces as described in Destanque, Appellants submit that there is no apparent reason to run counter

¹⁰ See Coburn, at column 2, lines 12-21.

to the explicit objectives of Coburn in order to arrive at the limitations recited in Claim 1. At best, the description of Coburn describes an improved mirror, which could be used to replace the mirrors described in Kelly or those described in Destanque. Therefore, the Examiner's Answer has failed to provide a supportable apparent reason to combine the known elements in the fashion recited in Claim 1.

C. Appellant stands on the arguments set forth in the Appeal Brief regarding Claim 16.

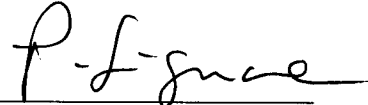
With respect to Claim 16, Appellant still believes that the final rejections are improper for the reasons provided in the Appeal Brief.

D. Conclusion

In view of the foregoing, it is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose or suggest the combined features set forth in Claims 1-16, 18, and 29-33. Accordingly, it is respectfully requested that the rejections of Claims 1-16, 18, and 29-33 be reversed.

Respectfully submitted,

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